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PATENT
Docket No. H 3033 PCT/US

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Application of Behler et al.

Serial No. 09/463,675 Examiner: J. Hardee
Filed: 05/12/00 Art Unit: 1751
TITLE: LOW VISCOSITY DISPERSION FOR PAPER OR TEXTILE PROCESSING

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the Assistant Commissioner for Patents on the date shown below.

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RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, DC 20231

Sir:

This paper is in response to the Examiner's Restriction Requirement dated November 13, 2000 in the instant application.

The Examiner contends that the present application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Group A, claims 16-30 drawn to compositions and methods for using compositions containing a fatty acid as the nonionic softener; Group B, claims 16-30, drawn to compositions and methods for using compositions containing a fatty alcohol as the

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nonionic softener; and Group C, claims 16-30, drawn to compositions and methods for using compositions containing a nonionic softener other than a fatty alcohol or a fatty acid.

Moreover, after having chosen one of groups A-C, the Examiner contends that Applicant is further required to elect one of the following inventions:

Group I, claims 16-22, drawn to compositions for softening paper and textile substrates; Group II, claims 23-30, drawn to processes for softening paper substrates, and Group III, claims 23-30, drawn to processes for softening textile substrates.

The Examiner states, at page 3 of Paper No. 7, "The inventions listed as Groups AI-CIII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The common structural feature which unites the invention does not make a contribution over the prior art in view of the reference marked X in the PCT search report."

Initially, Applicant would like to note that the claims presently pending in the application are claims 15-30, as is evidenced by Applicant's Preliminary Amendment filed January 28, 2000. Consequently, Applicant submits that it is **impossible** for Applicant to elect a specific group of the invention since all of the claims have not been addressed by the Examiner.

Applicant would also like to note that the premise, or lack thereof, upon which the Examiner's conclusion of lack of unity is based, is completely unclear to Applicant. More

particularly, under MPEP 1893.03(d) an Examiner, when making a lack of unity of invention requirement, **must** (1) list the different groups of claims, and (2) explain why each group lacks unity with each other group **specifically** describing the unique special technical feature in each group. While the Examiner has apparently satisfied the first requirement, the second requirement is clearly left unsatisfied. In an apparent attempt to satisfy the second requirement, the Examiner states, "...The common structural feature which unites the invention does not make a contribution over the prior art in view of the reference marked X in the PCT search report." **Clearly** this statement woefully fails to satisfy the second requirement cited above. Moreover, the relevance of this statement with respect to a unity of invention analysis and determination is unclear to Applicant.

The special technical feature in each Group identified by the Examiner is the nonionic softener component selected from mono- or diesters of glycerol with C_{6-22} fatty acids. For some reason unknown to Applicant, the Examiner appears to refer to the nonionic emulsifier (component (d)) as the nonionic softener which is actually component (a). Nevertheless, since **each and every** group identified by the Examiner possesses the same special technical feature, i.e., the nonionic softener of component (a), unity of invention as between these groups clearly exists.

The requirement is thus traversed based on lack of merit and reconsideration is requested. However, in an attempt to comply with the requirement of Rule 143, which is believed to be impossible in view of the Examiner's failure to address **all of the claims**,

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Applicant provisionally elects the invention of Group AI, with traverse, for further examination on the merits.

Respectfully submitted,

Steven J. Trzaska
(Reg. No. 36,296)
Attorney For Applicant(s)
(610) 278-4929

Cognis Corporation
Patent Department
2500 Renaissance Blvd., St. 200
Gulph Mills, PA 19406

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